



AF/3711/2W

Serial No. 10/072,429

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Serial No.: 10/072,429

Confirmation No.: 2615

In re Application of:

Jacques FAGOT et al.

On Appeal From:

Group Art Unit: 3711

Filed: February 7, 2002

Examiner: Stephen Luther Blau

For: SET OF GOLF CLUBS

TRANSMITTAL OF CORRECTED APPEAL BRIEF

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, Virginia 22313-1450

Sir:

Submitted herewith is a corrected Brief on Appeal in the above-identified application,
which cures the deficiencies alleged in the Notification mailed March 7, 2006.

Respectfully submitted,

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April 6, 2006

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BRIEF ON APPEAL

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I. REAL PARTY IN INTEREST

The real party in interest is Roger Cleveland Golf Company, Inc., of Huntington Beach, California, whose ownership interest appears in an Assignment recorded October 15, 2002 at Reel 013381, Frame 0669.

II. RELATED APPEALS AND INTERFERENCES

There is no pending appeal or interference or judicial proceeding known to appellants, the assignee or to the undersigned that may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision in this case.

III. STATUS OF CLAIMS

The application was originally filed with thirteen (13) claims. A Preliminary Amendment was filed February 7, 2002 amending claims 1 and 6, canceling claim 13, and adding claim 14. A Restriction/ Election of Species Requirement was mailed March 6, 2003, and a Response thereto was filed April 7, 2003, electing claims 1, 2, 5, 7, 8, 11, and 12 (readable on Figs. 1 and 8) for initial prosecution. Non-elected claims 3, 4, 6, 9, 10, 13, and 14 remain herein but are currently withdrawn from consideration. An Amendment was filed September 11, 2003 wherein claim 7 was amended and claim 15 was added. An Amendment Under 37 CFR 1.116 was filed March 3, 2004 wherein claim 1 was amended and claims 2 and 5, whose subject matter was added to claim 1, were canceled. A Request for Continued Examination (RCE) was filed June 2, 2004. A further Amendment was filed February 16, 2005 wherein claim 16 was added. Thus, the claims on appeal are claims 1, 7, 8, 11, 12, 15 and 16, the text of each of which appears in the Appendix attached to this Brief.

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IV. STATUS OF AMENDMENTS

As indicated in part III., above, the last Amendment filed February 16, 2005 was entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter of the claims on appeal is a set of golf club irons, that is iron-type golf clubs, the head of each iron in the set having the usual golf club elements and including a cavity-back (or perimeter weighted) design. See, for example, Figs. 1 and 2, and generally, specification page 1, line 11 through page 2, line 9.

The rear face cavity is bounded by a plurality of walls (of the perimeter weighting), the configuration of the rear face of the upper wall being particularly defined in independent claim 1 on appeal as follows:

...said head comprises at least one recess in the upper wall and at least one recess opens onto the rear face of said upper wall, the recess being elongate in the main direction of the upper wall,

The "at least one recess" is further defined in independent claim 1:

...and wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set, to cause the center of gravity of each head to vary in distance relative to said upper face from one iron to another.

See, for example, Figs. 8a-8c, and Figs. 10a-10c, and specification page 10, line 23 through page 11, line 14; and page 12, lines 11-33.

Each of dependent claims 8, 11, and 12 further specifies the subject matter of independent claim 1.

Dependent claim 8 specifies that "the volume of the recess represents between 0.4% and 5% of the volume of the head." See specification page 4, line 38 through page 5, line 7.

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Dependent claim 11 specifies that "the volume of all the recesses decreases from the long irons to the short irons."

And dependent claim 12 specifies that "the number of recesses decreases from the long irons to the short irons."

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The final Office Action Mailed March 28, 2005 stated the following rejections reversal of which is sought by this appeal:

1. Claims 1, 8, 11, 12 and 16 were rejected under 35 U.S.C. §103(a) over Peters U.S. Patent 6,093,112 in view of Besnard U.S. Patent 5,643,112.

2. Claims 7 and 15 were rejected under 35 U.S.C. §103(a) over Peters in view of Besnard, further in view of Japanese Patent Application Publication JP 7-213656 and Fenton U.S. Patent 5,290,036.

VII. ARGUMENT

1. The §103(a) Rejection of Claims 1, 8, 11, 12 and 16
Is Without Basis in the Cited Prior Art.

(a) Peters Does Not Configure The Upper Wall

Peters discloses club heads, each of which is made from incomplete club head parts, and during production temporarily has an incomplete rear lower wall, which during production is completed with a "weight insert" of a material more dense than the material of the incomplete club head part, thereby producing a completed club head which has no recesses. Peters does disclose that inclusion of such more dense material in the lower wall moves the club head center of gravity downward (vis-à-vis a location in a similar club head without such more dense material).

Significantly, the final Office Action (3/28/05) expressly admits that : "Peters lacks"

[A] At least one recess in the upper wall and

[B] said at least one recess opens onto a rear face of an upper wall,

[C], recess being elongated in a main direction of an upper wall,

[D] a volume of the recess being between .4 and 5% of the volume of the head,

[E] a volume of said at least one recess inside an upper wall varies from one iron to another within a set causing a [center of] gravity of each head to vary in distance relative to an upper face from one iron to another,

[F] the number of recesses or

[G] volume of recesses decreasing from long irons to short irons,

[H] and a set comprising at least three clubs.

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Office Action, March 28, 2005, page 3, lines 9-15; bracketed matter and underscoring added for emphasis here.

That Office Action, page 6, lines 66, 67, also admits "It is agreed that [J] Peters does not disclose an unfilled recess in any rear face."

The above-quoted admissions [A], [B], [C],[E], and [J] demonstrate that Peters does not disclose or suggest applicants' claimed invention as recited in independent claim 1. Peters in no way suggests the specific structure of the upper wall of each cavity-back, iron-type golf club head in a set, as claimed by Appellants.

The Advisory Action mailed September 11, 2005 alleged that:

Using both the designs of figures 20 and 22 would be consistent with Peters teaching of not sticking to one design throughout a set of club and provide structure which allows the center of gravity to be changed throughout a set as Peters sets show in figures 15 and 31.

But Peters nowhere even remotely suggests changing the location of the center of gravity of club heads in a set of golf clubs by a specific configuration of the upper wall of cavity-back club heads.

Peters teaches attaching a weighted insert to the lower perimeter region of the perimeter weighting of a cavity-back, iron-type golf club head. Peters does not discuss the volume of void recesses—particularly recesses in the upper wall. See again admissions [E], [F], and [G] above. Peters nowhere discloses or suggests varying the volume of a recess in a wall from one iron to another in a set of golf clubs. And Peters certainly makes no such disclosure or suggestion with respect to the upper wall of a cavity-back, iron-type golf club head. Peters is directed toward adding weight inserts to the lower region, not to configuring void recesses in the upper wall.

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(b) Besnard Does Not Vary Recess Volume
Among Clubs in a Set

Besnard (see Fig. 9) discloses one or more recesses opening through the rear face of the upper wall (of perimeter weighting in a golf club head), but Besnard does not disclose or suggest varying such recesses from one club to another within a set to thereby vary the location of the center of gravity of the club heads from one club to another in such a set. Besnard discloses gradually reducing the mass of the top wall within a single cavity-back, iron-type club head, from the heel region towards the toe region. As Besnard says:

The upper perimeter portion of the peripheral belt includes an elongated recess with a volume that is smaller than that of the main cavity and that increases in the direction of the toe. Thus, without affecting the peripheral overall mass distribution which provides a substantial head inertia, the position of the center of gravity can be adjusted precisely by providing a gradual lightening of the upper portion of the peripheral edge towards the toe, with the result of displacing the center of gravity towards the bottom and the heel of the club head.

Besnard '112, col. 2, lines 27-36. Appellants' claimed invention does not involve such gradual lightening of the upper wall from heel to toe in a single club head.

(c) There Is No Suggestion to Combine
Any Portions of Peters and Besnard

There is no disclosure or teaching in either Peters or Besnard which suggests combining any specific portions of those references effectively to anticipate or suggest Appellants' claimed invention. Peters nowhere suggests configuring the upper wall of a cavity-back, iron-type golf club head. Peters also nowhere suggests gradually lightening from heel to toe either the upper or lower wall of such a club head. And Besnard nowhere suggests adding weight inserts to any portions of such a club head. Attempting to combine the structures of Peters and Besnard would necessarily destroy and render ineffective one or both of the reference disclosures.

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The attempt in the Office Action to combine Peters and Besnard to anticipate or suggest Appellants' claimed invention, necessarily strongly relies on the teaching of Appellants' own disclosure and claims, which are not prior art here. Such hindsight reconstruction of the presently claimed invention is without basis in law or fact. Given these two cited references, it is not at all clear why one of ordinary skill in the art would readily arrive at Appellants' claimed invention.

For all of the foregoing reasons, the rejection of Appellants' independent claim 1 should be reversed.

(d) The Claim 8 Recess Volume Range
Is Nowhere Disclosed or Suggested

Neither Peters nor Besnard anywhere discloses or suggests the recess volume of 0.4 to 5% of the club head volume, as claimed in Appellants' claim 8. Patent drawings are not presumed to be to scale unless expressly stated to be so.

Page 4, lines 15-19 of the March 28, 2005 final Office Action concludes:

In view of the patent of Besnard it would have been obvious to modify the set of irons of Peters to have a volume of the recess being between .4 and 5% of the volume of the head in order to have a sufficient amount of weight removed from a top of a head to lower the center of gravity a sufficient distance.

No sound basis for that conclusion is stated in either the prior art or the Office Action. Not the slightest hint of the 0.4 to 5% range is anywhere suggested by either cited reference. Therefore, the rejection of Appellants' claim 8 should be reversed.

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(e) Neither Peters nor Besnard Discloses or Suggests
The Invention of Claims 11 and 12

As quoted at page 6, supra, the final Office Action admits that Peters does not disclose the subject matter of either Appellants' claim 11 (admitted item [F]) or Appellants' claim 12 (admitted item [G]).

Besnard discloses nothing about varying the number or volume of recesses from club to club within a set.

Thus, there is no disclosure or teaching in either Peters or Besnard which would have suggested the subject matter of either of Appellants' claims 11 or 12 to one of ordinary skill in the art.

The rejection of each of Appellants' claims 11 and 12 should be reversed.

For all the foregoing reasons, there is no sound baseis in either or both of Peters and/or Besnard for rejection of any of Appellants' claims 1, 8, 11, 12, and 16. Accordingly, Appellants respectfully request this Honorable Board to reverse the rejection of each of claims 1, 8, 11, 12 and 16.

2. The §103(a) Rejection of Claims 7 and 15 Should be Reversed
For the Same, Above-Stated Reasons

Appellants' dependent claims 7 and 15 are dependent from claims 1 and 7, respectively. Appellants rely on the same resons stated above herein for patentability of independent claim 1, to support patentability of dependent claims 7 and 15.

Reversal of the rejection of each of dependent claims 7 and 15 is therefore respectfully requested.

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VIII. CONCLUSION

As demonstrated above herein, the Peters and Besnard references are inadequate, individually and collectively, as bases for rejection of any of Appellants' independent claim 1 and each of dependent claims 7, 8, 11, 12, 15, and 16. Therefore, reversal of the stated rejections of those claims, and allowance of all claims 1, 7, 8, 11, 12, 15 and 16, are respectfully requested.

Respectfully submitted,

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April 6, 2006

(originally December 30, 2005)

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APPENDIX

CLAIMS ON APPEAL

1. A set of golf club irons, each iron of said set having a head, said head having a rear face, said rear face having a cavity bounded by a plurality of walls, wherein said plurality of walls comprises at least one lower wall forming a sole and an upper wall, said upper wall having a plurality of faces, said plurality of faces comprising a rear face, an upper face, a lower face facing the cavity and a plurality of lateral faces, wherein said head comprises at least one recess in the upper wall and said at least one recess opens onto the rear face of said upper wall, the recess being elongate in the main direction of the upper wall, and wherein a volume of said at least one recess inside said upper wall varies from one iron to another within said set, to cause the center of gravity of each head to vary in distance relative to said upper face from one iron to another.

7. The set of golf clubs as claimed in claim 1, wherein the recess is filled with a low-density material.

8. The set of golf clubs as claimed in claim 1, wherein the volume of the recess represents between 0.4% and 5% of the volume of the head.

11. The set of golf clubs as claimed in claim 1, wherein the volume of all the recesses decreases from the long irons to the short irons.

12. The set of golf clubs as claimed in claim 1, wherein the number of recesses decreases from the long irons to the short irons.

15. The set of golf clubs as claimed in claim 7, wherein said low-density material comprises a polyurethane foam.

16. The set of golf clubs as claimed in claim 1, wherein the set comprises at least three golf clubs.

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EVIDENCE APPENDIX

No evidence was submitted in this application pursuant to any of 37 C.F.R. §§1.130, 1.131, or 1.132.

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RELATED PROCEEDINGS APPENDIX

As stated in part II of this brief, none.

- (B) Table of Contents page(s);
- (C) Real party in interest page(s);
- (D) Related appeals and interferences page(s);
- (E) Status of claims page(s);
- (F) Status of amendments page(s);
- (G) Summary of claimed subject matter page(s);
- (H) Grounds of rejection to be reviewed on appeal page(s);
- (I) Argument page(s);
- (J) Claims appendix page(s);
- (K) Evidence appendix page(s);
- (L) Related proceedings appendix page(s).

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by appellant. Even if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner must continue to make the rejection in the examiner's answer, unless an amendment obviating the rejection has been entered.

A timely filed brief will be referred to the examiner for consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. See MPEP § 1207.04.<

****>**

1205.03 Non-Compliant Appeal Brief and Amended Brief< [R-3]

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner ****>**and the Board. The examiner will review the brief to ensure that the required items of the brief are present. Both the Board and the examiner will review the brief for compliance with the content requirements of the brief (37 CFR 41.37(c)). 37 CFR 41.37(d)< provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given **** 1 month or 30 days** from the mailing of the notification of non-compliance, whichever is longer ****>**to file an amended brief.<

Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The ***>Office<** may use the form paragraphs set forth below or form PTOL-462, "Notification of ****>Non-Compliant Appeal Brief (37 CFR 41.37)<**" to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

Under 37 CFR ***>41.37(d)<**, the appellant may file an amended brief to correct ***>the<** deficiencies in the original brief. Moreover, if appellant disagrees with the ***** holding of noncompliance, a petition under 37 CFR 1.181 **>or 41.3<** may be filed. **>Filing a petition will not toll the time period.** Appellant must timely reply to the notice or the Office communication that requires an amended brief.

In response to the Notice of Non-Compliant Appeal Brief (37 CFR 41.37) or the Office communication that requires an amended brief, appellant is required to file an amended brief that is either a complete new brief with the required corrections or a replacement section(s) as noted below:

(A) When the Office holds the brief to be defective solely due to appellant's failure to name the real party in interest as required by 37 CFR 41.37(c)(1)(i), an entire new brief need not, and should not, be filed. Rather, a paper identifying by name the real party in interest will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

(B) When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

The examiner should not require a corrected brief for minor non-compliance in an appeal brief (e.g., the brief has a minor error in the title of a section heading). The following are a few other examples where

the examiner may accept a brief that has minor non-compliance:

(A) If the evidence appendix and related proceedings appendix are missing, but the record is clear that there is no evidence submitted and no related proceedings listed in the related appeals and interferences section, the examiner may accept the brief and state in the examiner's answer that it is assumed that the appellant meant to include both appendixes with a statement of "NONE."

(B) If appellant only presents arguments for a dependent claim but not for the independent claim in a group of claims that are subject to the same ground of rejection, the examiner may accept the brief and fully explain how the limitations of the independent claim are rejected and address the appellant's arguments regarding the dependent claim in the examiner's answer.

(C) If appellant fails to include a copy of the claims involved in the appeal in the claims appendix

section of the brief, the examiner may either: (1) provide a copy of the claims in the examiner's answer, or (2) object to the appeal brief and require an amended brief.<

Once the brief has been filed, a petition to suspend proceedings may be considered on its merits, but will be granted only in exceptional cases, such as where the writing of the examiner's answer would be fruitless or the proceedings would work an unusual hardship on the appellant.

For a reply brief, see MPEP § *>1208<.

**>The following forms: Form PTOL-461, "Communication Re: Appeal" (Rev. 9-04 or later) – reproduced in MPEP § 1204.01, Form PTOL-462, "Notification of Non-Compliant Appeal Brief (37 CFR 41.37)" (Rev. 9-04 or later), or Form PTOL-462R, "Notification of Non-Compliant Appeal Brief (37 CFR 41.37) in *Ex Parte* Reexamination" (Rev. 9-04 or later) or the form paragraphs below may be used concerning defects in the appeal brief.<